

REMARKS/ARGUMENTS

The following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art. Claims 1, 8, 15 & 20 have been amended.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-2, 6, 8, 11-12, 15-16, 20-21 and 25 under 35 U.S.C. §103(a) as being unpatentable over Scott Corey Miller (U.S. Patent No. 6,421,707 and Miller hereinafter) in view of Pamela Sue Austin (U.S. Patent No. 6,157,924 and Austin hereinafter).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180, USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Independent claims 1, 8, 15, and 20 include limitations that are not disclosed or suggested by Miller and Austin. In particular, Applicant's independent claims include the limitation, or limitation similar thereto, of **generating a notice of the new email, wherein a content of the notice is customized** per the user profile database.

As stated by the Examiner, Miller fails to disclose generating a customized notice of the new email per the user profile database. (Office Action, Item 8, page 3). Miller discloses user-selected **delivery** methods for standard mail notifications and mail messages, but fails to disclose or suggest generation of a notice of the new email, where a content of the notice is customized. (Miller, col. 4, lines 49-51). However, Examiner cites Austin for such teaching.

Austin also fails to disclose the limitations. Rather, Austin specifically discloses a financial statement **delivery system**, which ensures consistency of statement presentation

regardless of the medium in which the statement is delivered to a customer. (Austin, col. 9, lines 14-17). A customer may change the **delivery medium** of future statements, electing to receive statements in Excel or in email format. (Austin, col. 10, lines 13-14). Moreover, Austin discloses methods for information retrieval, where the “Retrieve an Archive Statement” user interface 58 allows a customer to select the accounts she wishes to obtain statements for, the dates for those statements, and what **delivery medium** to receive the selected statements in. (Austin, col.10, lines 7-12).

Although Austin discloses formatting and delivering requested information to the user in the preferred medium, Austin fails to disclose generating a notice of a new email, where the content of the notice is customized. The email message, containing the requested information, of Austin is not a notice of a new email. A **notice** of a new email is distinct from an email message. Accordingly, Austin fails to disclose the claimed limitations.

Since Miller and Austin, in combination, fail to teach each element of the above limitations and there is no motivation to modify either Miller or Austin to include such limitations, the references cannot render independent claims 1, 8, 15, and 20 as obvious. Accordingly, Applicant respectfully submits that independent claims 1, 8, 15, and 20 are in condition for allowance.

Furthermore, the remaining claims depend from one of the independent claims discussed above and therefore also include the distinguishing claim limitations. As a result, the remaining claims are also not anticipated and are patentable.

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants’ silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding the claim.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Naya Chatterjee at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

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